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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,159	12/02/2003	David Mark Pascoe	19345-095761	8881

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EXAMINER

COMPTON, ERIC B

ART UNIT PAPER NUMBER

3726

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/726,159

Applicant(s)

PASCOE ET AL.

Examiner

Eric B. Compton

Art Unit

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,10,13,21,22 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,10,13,21,22 and 24 is/are allowed.
- 6) ☒ Claim(s) 25-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 6,061,907 to Victoria et al.

Regarding claim 25, Victoria discloses a differential housing assembly (see Fig. 2) comprising a housing (34) comprising a bell shaped body (34) extending between a cylindrical first end (60) and an opposing annular second end (42) having a ring gear (44) integrally formed (by laser welding, see Col. 3, line 38) thereon.

Note: the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973). Furthermore, "The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

Regarding claims 26-34, these features are disclosed (or inherently provided for) by the reference as well. See Figure 2-11.

3. Claims 25-30 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 09-229162 to YANAGAWA.

Regarding claim 25, YANAGAWA discloses a differential housing assembly (see Fig. 1) comprising a housing (18) comprising a bell shaped body (19) extending between a cylindrical first end (21L) and an opposing annular second end (21R) having a ring gear (26) integrally formed thereon. See *also* U.S. Pat. 6,146,304 (Figure 6); JP 2000-266162; and JP 11-072158.

Regarding claims 26-30, these features are disclosed (or inherently provided for) by the reference as well.

4. Claims 25-34 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 62-132055 to Tozawa.

Regarding claim 25, Tozawa discloses a differential housing assembly (see Fig. 1) comprising a housing (1) comprising a bell shaped body (2) extending between a cylindrical first end and an opposing annular second end having a ring gear (6) integrally formed thereon.

The JPO English Abstract discloses:

**PURPOSE:** To form a case in small size and in light weight, by forming a driven gear part and a case body part, which arranges spindles to be mounted, to be forged by special steel and integrally molded.

**CONSTITUTION:** A differential gear case 1 comprises a main unit 2 and a cover member 4, and the main unit 2 is formed by integrally forging a case body part 5 and a driven gear part 6 by special steel. The case body part 5 arranges spindles 7 to be mounted, and the case 1 fits one axle 8 of the right and left axles of an automobile to the case body part 5 while the other axle 9 to the cover member 4. Power from an engine is transmitted to the axles 8, 9 through the driven gear 6, case body part 5, spindles 7 and differential gear wheels 10, 11. Accordingly, the case can be formed in small size and also in light

weight by obtaining sufficient strength.

Regarding claims 26-34, these features are disclosed (or inherently provided for) by the reference as well.

***Allowable Subject Matter***

5. Claims 1-2, 10, 13, 21, 22, and 24 are allowed.

***Response to Arguments***

6. Applicant's arguments filed June 23, 2006 have been considered but they are not found fully persuasive.

7. Applicant's amendment and arguments in support thereof with respect to the method claims 1-2 10, 13, 21-22, and 24 have been found persuasive.

8. However, the product-by-process claims are still anticipated by the prior art. As noted above, the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973). Furthermore, "The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). Thus, the limitation that the "said housing formed form a steel rod," is deemed anticipated since the prior art teaches the same structural

limitation, despite being formed by a materially different manufacturing process.

Applicant's arguments with respect to these issues and thereby moot.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat. 6,945,898, discloses "as shown in FIG. 1a, a ring gear 46a is formed integrally with the lid 24a to eliminate the step of welding the ring gear 24a to the housing 12." Col. 5, lines 4-6. However, the reference does not disclose the ring is formed on the housing.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

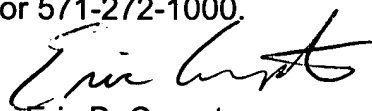
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Eric B. Compton  
Primary Examiner  
Art Unit 3726